

Atty. Docket No.
003797.00616

PATENT
RECEIVED
CENTRAL FAX CENTER

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

JAN 23 2004

In re Patent Application of:

Jamie WAKEAM ET AL.

Examiner: TBA

U.S. Pat. App. No.: 10/646,473

Group Art Unit: 2182

Filed: August 21, 2003

For: ELECTRONIC INK PROCESSING

STATEMENT UNDER 37 C.F.R. §1.704(d)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with 37 C.F.R. 1.704(d), Applicants hereby state that each item of information contained in the attached Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart application, and that this communication was not received by any individual designated in 37 C.F.R. §1.56(c) more than thirty days prior to the filing of the Information Disclosure Statement.

Respectfully submitted,

BANNER & WITCOFF, LTD.

January 22, 2004

By: Thomas L. Evans

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PATENT COOPERATION TREATY

RECEIVED

DEC 24 2003

From the INTERNATIONAL SEARCHING AUTHORITY

To:
WILLIAM F. BAUCHOLEZ
BANNER & WITCOFF, LTD.
11TH FLOOR
1001 G STREET, NW
WASHINGTON, DC 20001-4597

PCT BANNER & WITCOFF

NOTIFICATION OF TRANSMITTAL OF
THE INTERNATIONAL SEARCH REPORT
OR THE DECLARATION

(PCT Rule 44.1)

Date of Mailing **22 DEC 2003**
(day/month/year)

Applicant's or agent's file reference
03/97.00645

FOR FURTHER ACTION See paragraphs 1 and 4 below

International application No.
PCT/US03/26172

International filing date
(day/month/year)
21 August 2003 (21.08.2003)

Applicant
MICROSOFT CORPORATION

1. ☒ The applicant is hereby notified that the international search report has been established and is transmitted herewith.

Filing of amendments and statement under Article 19:

The applicant is entitled, if he so wishes, to amend the claims of the international application (see Rule 46):

When? The time limit for filing such amendments is normally two months from the date of transmittal of the international search report.

Where? Directly to the International Bureau of WIPO, 34, chemin des Colombes
1211 Geneva 20, Switzerland, Facsimile No.: (41-22) 740.14.35

For more detailed instructions, see the notes on the accompanying sheet.

2. ☐ The applicant is hereby notified that no international search report will be established and that the declaration under Article 17(2)(a) to that effect is transmitted herewith.

3. ☐ With regard to the protest against payment of (an) additional fee(s) under Rule 40.2, the applicant is notified that:

- ☐ the protest together with the decision thereon has been transmitted to the International Bureau together with the applicant's request to forward the texts of both the protest and the decision thereon to the designated Office.
☐ no decision has been made yet on the protest; the applicant will be notified as soon as a decision is made.

4. **Reservations**

Shortly after 18 months from the priority date, the international application will be published by the International Bureau. If the applicant wishes to avoid or postpone publication, a notice of withdrawal of the international application, or of the priority claim, must reach the International Bureau as provided in Rules 90 bis.1 and 90 bis.3, respectively, before the completion of the technical preparations for international publication.

Within 19 months from the priority date, but only in respect of some designated Offices, a demand for international preliminary examination must be filed if the applicant wishes to postpone the entry into the national phase until 30 months from the priority date (in some Offices even later); otherwise the applicant must, within 20 months from the priority date, perform the prescribed acts for entry into the national phase before those designated Offices.

In respect of other designated Offices, the time limit of 30 months (or later) will apply even if no demand is filed within 19 months.

See the Annex to Form PCT/IB/301 and, for details about the applicable time limits, Office by Office, see the PCT Applicant's Guide, Volume II, National Chapters and the WIPO Internet site.

Name and mailing address of the ISA/US
Mail Stop PCT, Attn: ISA/US
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450
Telephone No. (703) 305-3130

Form PCT/ISA/220 (April 2002)

Authorized officer

Heather Hammond
Telephone No. 703-305-4700

(See notes on accompanying sheet)

PATENT COOPERATION TREATY

PCT

INTERNATIONAL SEARCH REPORT

(PCT Article 18 and Rules 43 and 44)

Applicant's or agent's file reference 03797.00665		FOR FURTHER ACTION		see Notification of Transmittal of International Search Report (Form PCT/ISA/210) as well as, where applicable, Annex 5 below	
International application No. PCT/US03/26172		International filing date (day/month/year) 21 August 2003 (21.08.2003)		(Earliest) Priority Date (day/month/year)	
Applicant MICROSOFT CORPORATION					

This International search report has been prepared by this International Searching Authority and is transmitted to the applicant according to Article 18. A copy is being transmitted to the International Bureau.

This international search report consists of a total of 3 sheets.

☒ It is also accompanied by a copy of each prior art document cited in this report.

1. Basis of the Report

a. With regard to the language, the international search was carried out on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.

☐ the international search was carried out on the basis of a translation of the international application furnished to this Authority (Rule 25.1(i)).

b. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the international search was carried out on the basis of the sequence listing:

☐ consisted in the international application in written form.

☐ filed together with the international application in computer readable form.

☐ furnished subsequently to this Authority in written form.

☐ furnished subsequently to this Authority in computer readable form.

☐ the statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.

☐ the statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

2. ☐ Certain claims were found unsearchable (See Box I).

3. ☐ Unity of invention is lacking (See Box II).

4. With regard to the text,

☒ the text is approved as submitted by the applicant.

☐ the text has been established by this Authority to read as follows:

5. With regard to the abstract,

☐ the text is approved as submitted by the applicant.

☒ the text has been established, according to Rule 38.2(b), by this Authority as it appears in Box III. The applicant may, within one month from the date of mailing of this international search report, submit comments to this Authority.

6. The figure of the drawings to be published with the abstract is Figure No. 5

☒ as suggested by the applicant.

☐ because the applicant failed to suggest a figure.

☐ because this figure better characterizes the invention.

☐ None of the figures

Form PCT/ISA/210 (first sheet) (July 1998)

INTERNATIONAL SEARCH REPORT

International application No.

PCT/US03/26172

Box III TEXT OF THE ABSTRACT (Continuation of Item 5 of the first sheet)

The technical features mentioned in the abstract do not include a reference sign between parentheses (PCT Rule 8.16(4)).

NEW ABSTRACT

System, methods, and computer readable media for making rich, flexible, and more natural electronic ink annotations in an electronic document(200) include creating a first context node associated with a first portion of a base portion of an electronic document; creating a second context node associated with an annotation to the base; and linking the second context node with the first context node.

Form PCT/ISA/210 (continuation of first sheet(2)) (July 1998)

INTERNATIONAL SEARCH REPORT

International application No.

PCT/US03/26172

A. CLASSIFICATION OF SUBJECT MATTER		
IPC(Int.) : G06K 9/00		
US CL : 715715/512, 517, 530; 3820/119		
According to International Patent Classification (IPC) or to both national classification and IPC		
B. FIELDS SEARCHED		
Minimum documentation searched (classification system followed by classification symbols)		
U.S. : 715715/512, 517, 530; 3820/119		
Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched		
Electronic data base consulted during the international search (name of data base used, where practicable, search terms used)		
C. DOCUMENTS CONSIDERED TO BE RELEVANT		
Category *	Citation of documents, with indication, where appropriate, of the relevant passages	Relevant to claim No.
A	US 5,359,897 A (BROWN et al) 24 September 1994 (24.09.1994)	1-65
A	US 5,911,013 A (TANISSE) 06 June 1999 (06.06.1999)	1-65
A	US 5,394,484 A (CASEY et al) 28 February 1995 (28.02.1995)	1-65
<input type="checkbox"/> Further documents are listed in the continuation of Box C. <input type="checkbox"/> See patent family sources.		
* Special categories of cited documents: - "A" documents defining the general state of the art which is not considered to be of particular relevance - "B" earlier application or patent published on or after the international filing date of particular relevance - "L" documents which may draw attention to priority claims or which it should be considered the publication date of another cited document or other special reason (as specified) - "O" documents relating to an oral disclosure, use, exhibition or other means - "P" documents published prior to the international filing date but later than the priority date claimed - "X" later documents published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention - "Y" documents of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step where the document is taken alone - "Z" documents of particular relevance; the claimed invention cannot be considered to involve an inventive step where the document is considered with one or more other cited documents, such combination being obvious to a person skilled in the art - "A" documents prior art of the same patent family		
Date of the actual completion of the international search		Date of mailing of the international search report
05 December 2003 (05.12.2003)		22 DEC 2003
Name and mailing address of the ISA/US Mail Stop PCT, Attn: ISA/US Communication for Patents P.O. Box 1430 Alexandria, Virginia 22315-1430 Facsimile No. (703) 305-3230		Authorized officer Heather Harwood Telephone No. 703-305-4700

Form PCT/ISA/210 (second sheet) (July 1998)

NOTES TO FORM PCT/ISA/220

These Notes are intended to give the basic instructions concerning the filing of amendments under Article 19. The Notes are based on the requirements of the Patent Cooperation Treaty, the Regulations and the Administrative Instructions under that Treaty. In case of discrepancy between these Notes and those requirements, the latter are applicable. For more detailed information, see also the PCT Applicant's Guide, a publication of WIPO.

In these Notes, "Article," "Rule" and "Section" refer to the provisions of the PCT, the PCT Regulations and the PCT Administrative Instructions, respectively.

INSTRUCTIONS CONCERNING AMENDMENTS UNDER ARTICLE 19

The applicant has, after having received the international search report, one opportunity to amend the claims of the international application. It should however be emphasized that, since all parts of the international application (claims, description and drawings) may be amended during the international preliminary examination procedure, there is usually no need to file amendments of the claims under Article 19 except where, e.g. the applicant wants the latter to be published for the purposes of provisional protection or has another reason for amending the claims before international publication. Furthermore, it should be emphasized that provisional protection is available in some States only.

What parts of the international application may be amended?

Under Article 19, only the claims may be amended.

During the international phase, the claims may also be amended (or further amended) under Article 34 before the International Preliminary Examining Authority. The description and drawings may only be amended under Article 34 before the International Preliminary Examining Authority.

Upon entry into the national phase, all parts of the international application may be amended under Article 28 or, where applicable, Article 41.

When?

Within 2 months from the date of transmittal of the international search report or 16 months from the priority date, whichever time limit expires later. It should be noted, however, that the amendments will be considered as having been received on time if they are received by the International Bureau after the expiration of the applicable time limit but before the completion of the technical preparations for international publication (Rule 46.1).

Where not to file the amendments?

The amendments may only be filed with the International Bureau and not with the receiving Office or the International Searching Authority (Rule 46.2).

Where a demand for international preliminary examination has been filed, see below.

How?

Either by cancelling one or more entire claims, by adding one or more new claims or by amending the text of one or more of the claims as filed.

A replacement sheet must be submitted for each sheet of the claims which, on account of an amendment or amendments, differs from the sheet originally filed.

All the claims appearing on a replacement sheet must be numbered in Arabic numerals. Where a claim is cancelled, no renumbering of the other claims is required. In all cases where claims are renumbered, they must be renumbered consecutively (Administrative Instructions, Section 205(b)).

The amendments must be made in the language in which the international application is to be published.

What documents must/ may accompany the amendments?

Letter (Section 205(b)).

The amendments must be submitted with a letter.

The letter will not be published with the international application and the amended claims. It should not be confused with the "Statement under Article 19(1)" (see below, under "Statement under Article 19(1)").

The letter must be in English or French, at the choice of the applicant. However, if the language of the international application is English, the letter must be in English; if the language of the international application is French, the letter must be in French.